

### **REMARKS**

Claims 1-4, 6-12, 14-23, 25-31, 33-40, 42-48, 50-51, 70-73, 75-79, 81-82 and 106 are pending in the application.

The Examiner has rejected claim 70, and the claims that depend therefrom, under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In the Decision on Appeal, the Board of Patent Appeals and Interferences determined that these claims were clearly directed to a machine and, thus, did not sustain the rejection under 35 U.S.C. § 112, second paragraph. Applicants respectfully request withdrawal of this rejection.

The Examiner has rejected claims 1-4, 6-12, 15-17, 20-23, 25-31, 34-36, 39-48, 51, 70-73, 75-79 and 82 under 35 U.S.C. § 103(a) as unpatentable over Wizig (U.S. Patent No. 6,735,569) in view of Warady et al. (U.S. Patent No. 6,067,522). Claim 74 has been rejected by the Examiner, but its status is cancelled. The Examiner has rejected claims 14, 18-19, 33, 37-38, 50, 81, and 106 under 35 U.S.C. § 103(a) as being unpatentable over Wizig and Warady in view of Spurgeon (U.S. Patent No. 5,890,129). In the Decision on Appeal, the Board of Patent Appeals and Interferences sustained these rejections.

However, Applicants respectfully request reconsideration of the rejection of claims 1-4, 6-12, 15-17, 20-23, 25-31, 34-36, 39-48, 51, 70-73, 75-79 and 82 under 35 U.S.C. § 103(a) as unpatentable over Wizig in view of Warady et al. and claims 14, 18-19, 33, 37-38, 50, 81, and 106 under 35 U.S.C. § 103(a) as being unpatentable over Wizig and Warady in view of Spurgeon, in view of the following.

Applicants hereby submit objective evidence of non-obviousness, presented by way of the Declaration of Keith Scally under 37 C.F.R. § 1.132 (“Declaration”) transmitted herewith to rebut the determination of the Examiner, and sustained by the Board of Patent Appeals and Interferences, that the pending claims are obvious in view of the cited art. “Affidavits or declarations . . . containing evidence of criticality or unexpected results, commercial success, long-felt but unsolved needs, failure of others, skepticism of experts, *etc.*, *must be considered by the examiner in determining the issue of obviousness* of claims for patentability under 35 U.S.C. 103.” M.P.E.P. § 716.01(a) (emphasis added).

The Declaration provides evidence, rebutting any prima facie case of obviousness established by the Examiner, that the invention embodied in the claims has been recognized in the industry as an innovative approach to consumer-driven health plans, has been praised by customers, and has made an impact on the healthcare industry.

Exhibit A of the Declaration refers to a commercial embodiment of the invention claimed in the present application, “Benefits Configurator”, and includes specific references to the features currently claimed. Declaration ¶¶ 4, 5, and 6. Exhibit A recites statements made by a third-party customer of the Benefits Configurator, noting that this product is “at the *forefront* of the movement toward consumer-driven health plans” and, employing the Benefits Configurator, “is in the *best interest of our employees* because it allows them more freedom and flexibility to decide how to apply their benefit dollars.” Declaration ¶ 7. The foregoing statement evidences that the Benefits Configurator takes an innovative approach to consumer-driven healthcare that significantly benefits its users. Exhibit A also notes an existing problem solved by the Benefits Configurator, namely, to

allow a company with many employees provide such employees with choices in their health care coverage, thereby evidencing that the Benefits Configurator solves a need in the industry for consumer-driven healthcare. Declaration ¶ 8.

Exhibit B of the Declaration also refers to the Benefits Configurator. Declaration ¶ 9. Exhibit B evidences that the Benefits Configurator was slated for discussion as a “cutting edge initiative” in healthcare. Declaration ¶ 10.

Exhibit C of the Declaration also refers to the Benefits Configurator. Declaration ¶ 11. Exhibit C references the Choicelinx, its “primary product” being the Benefits Configurator at that time, achieving a “Best in Class Designation” and being a “Leader in Consumer-Driven Healthcare Technology Solutions for the Health Insurance Industry.” Declaration ¶ 12. Further, the article notes that the Blue Cross and Blue Shield Association chose Choicelinx for its innovative product selection and enrollment technology, recognizing the strength of the technology offered by Choicelinx. Declaration ¶ 12.

Finally, there is a clear nexus between the merits of the claimed invention and the evidence of secondary considerations, as required by M.P.E.P. § 716.01(b), given that each of these articles focuses on the configurable nature of the benefits (i.e., receiving “line item” selections from the employee as claimed) as being innovative and recognized in the industry.

In view of the foregoing, reconsideration and timely allowance of the pending claims are respectfully requested. Should the Examiner feel that there are any issues outstanding after consideration of the response; the Examiner is invited to contact the Applicants' undersigned representative to expedite prosecution.

Respectfully submitted,

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